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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,679	03/12/2001	Geoffrey B. Rhoads	P0329	1863

23735 7590 12/02/2004

DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

RAMAN, USHA

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/804,679

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

Usha Raman

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20042608
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

Information Disclosure Statement

1. The information disclosure statement filed August 26th 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Response to Arguments

2. Applicant argues that the reference fails to show certain features of applicant's invention. However, Kenner discloses the desired clip *only if the user has not gone over his charge limits* (see column 24, lines 50-57). Thus, a fee must be exchanged before the clip is downloaded or transmitted. As a result, applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kenner et al (US Pat. 5,956,716).

In regards to claim 1, Kenner discloses a method for distributing video over the Internet. A content provides a web-page containing "video guide" that has the information user is interested in and informs the user of what subscription content is available (i.e. the subscribed-to video clips available to the user). A user sends a request for a content by selecting a link from the web page containing subscription content. Note column 23, lines 12-17 and lines 20-24. The system of Kenner therefore has the method of displaying to a consumer a listing of video titles (by informing the user what subscription content is available). A primary index manager (PIM) receives and processes user requests based on subscription privileges. Note column 24, lines 15-18. The system further comprises the method of receiving a signal indicative of the video title selected by the user (i.e. user clicks on a link to indicate the content he is interested in subscribing to, which is received by the primary index manager). Kenner discloses that billing records are updated for each request made by the user for a content that must be paid for each time it is viewed (i.e. pay per view) that a request is processed if the user has enough the charge limits (i.e. if the user does not have enough charge limits, the request for clip is denied). Note column 27, lines 28-30 and column 24, lines 47-50, 56-60. Therefore the system has the method of exchanging a fee. Upon proper authorization, the PIM initiates a DSI process to download the desired clip to the user's terminal. The DSI receives the requested clip from the appropriate source, and adds data derived from the users ID by adding noise at various points along the stream, i.e.

watermarks the video "on-the-fly" and transmits the clip to the requesting user. Note column 24, lines 14-23, column 25, lines 55-57, and lines 64-67. Kenner states that the watermarking authorities to track down copyright violators. Note column 26, lines 10-13. The system of Kenner therefore has the capability to watermark the requested video "on-the-fly" and transmit the video to the consumer.

In regards to claims 2 and 8, Kenner discloses watermarking the video with consumer ID. Note column 25, lines 64-67.

Claim Rejections - 35 USC § 103

5. Claims 3-4, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (US Pat 5,956,716) in view of Moskowitz et al. (US Pat. 5,822,432).

In regards to claims 3, 4, 7 and 9, Kenner lacks the method of watermarking the video with more than one data from the list recited in claim 2 (i.e. a date identifier, an internet site from which the selected video and an identifier of an internet address to which the selected video is transmitted).

Moskowitz et al. discloses watermarking media contents with a plurality of data, including "metering" watermarks on content that identify the consumer, license agreement and terms and usage, watermarks containing other pertinent information about the content, such as where to locate other copies of the purchased content or similar contents can be included in the content. An

example of such information watermarked is watermarking the video content with one or more URLs. Note column 9, lines 29-40 in Moskowitz et al.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Kenner by watermarking the requested content with requester and/or distributor Internet address over the video content, as taught by Moskowitz et al. thus watermarking up to three data from the list recited in claim 2. The motivation is to provide additional information identifying the publisher location (the originating source), consumer location (the intended destination), and/or consumer ID (identifying the intended recipient) to track down copyright violators.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (US Pat. 5,956,716) in view of Fridrich (US Pat. 6,101,602).

In regards to claim 6, Kenner lacks the method of watermarking the video with an identifier of the date.

Fridrich discloses watermarking a media content with optional data such as a time and date identifier in addition to identifiers identifying the content itself. Note column 7, lines 5-8.

It would have been obvious to one of ordinary skill to modify the system of Kenner in view of Fridrich's teaching by watermarking a media content with a date identifier. The motivation would be to provide means of identifying the date a purchase transaction was processed.

7. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (US Pat 5,956,716) in view of Moskowitz et al. (US Pat. 5,822,432) as applied to claim 4 above, and further in view of Fridrich (US Pat. 6,101,602).

In regards to claim 5, as discussed above for claim 4, the modified system Kenner in view of Moskowitz has the method of watermarking the video with three data recited in the list. The modified system however lacks the method of watermarking the video with the fourth data from the list (namely identifier of the date).

Fridrich discloses watermarking a content with optional data such as a time and date identifier in addition to identifiers identifying the content itself. Note column 7, lines 5-8.

It would have been obvious to one of ordinary skill to further modify the system of Kenner in view of Moskowitz with Fridrich's teaching of watermarking a content with a date identifier. The motivation is to provide means of identifying the date a purchase transaction was processed and use that in conjunction with other watermark data to track down copyright violators.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
9. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (703) 305-0376. The examiner can normally be reached on Mon-Fri: 9am-6pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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VIVEK SRIVASTAVA
PRIMARY EXAMINER